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Paper

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

FAXED

ALCOA, INC.
Junior Party
(Application 09/473,246),

AUG 20 2004

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BRIDGESTONE GRAPHIC TECHNOLOGIES, INC.
Senior Party
(Patent 6,017,657).

Patent Interference No. 105,176

ORDER - RULE 634

Before: SCHAFER, Administrative Patent Judge.

Alcoa has filed 1) an unopposed motion to file a petition to correct the inventorship of involved Patent 6,017,657 and 2) an unopposed motion to accept the filing of a settlement agreement. The motions and petition are granted.

Findings of Fact

- F 1. This interference is between Application 09/473,246 and Patent 6,017,657.
- F 2. When the interference was declared the assignee of record of the 246 application was Alcoa, Inc.
- F 3. When the interference was declared the records of the Patent and Trademark Office indicated that the assignee of the 657 patent was Bridgestone Graphic Technologies, Inc.

- F 4. Applied Optical Technologies, Inc. is apparently the successor-in-interest to Bridgestone.
- F 5. By an assignment date July 2, 2004, Applied Optical assigned "full and exclusive right, title and interest" to the invention of the 657 patent to Alcoa.
- F 6. Alcoa has filed a motion under 37 CFR § 1.634 and a petition under 37 C.F.R. § 1.324 to correct the inventorship of the 657 patent.
- F 7. In particular it is said that Mark W. Schaefer, Thomas L. Levendusky, Neville C. Whittle, Robert B. Larsen, and Simon Sheu should be added as joint inventors.
- F 8. Mark W. Schaefer, Thomas L. Levendusky, Neville C. Whittle, Robert B. Larsen, and Simon Sheu have each filed a statement averring that the error in inventorship occurred through inadvertence without deceptive intent. Papers 32-36.
- F 9. Brian R. Mentz and Timothy F. Dolan, the currently named inventors of the 657 patent, each state that they agree with the change of inventorship. Papers 36-37.
- F 10. Alcoa and Applied Optical have each consented to the change in inventorship. Papers 39 and 40.
- F 11. Alcoa has authorized the payment of the fee for changing inventorship. Paper 31, p. 3.
- F 12. Alcoa has also filed a proposed Certificate of Correction, correcting the inventorship. Paper 41.

Analysis

Section 256 of 35 U.S.C. authorizes the Director to correct the inventorship of patents where all the inventors and assignees request correction and the inventorship was incorrect due to an error made without any deceptive intent:

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

Section 1.324 of 37 CFR implements the statutory provision. The regulation requires that a petition to add inventors to a patent must include a statement from each added inventor that the error occurred without deceptive intent, a statement from each currently named inventor agreeing to the

change, a statement by all the assignees of the inventors agreeing to the change in the inventorship, and the appropriate fee:

Any petition pursuant to paragraph (a) of this section must be accompanied by:

- (1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;
- (2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;
- (3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter; and
- (4) The fee set forth in § 1.20(b).

37 CFR § 1.324.

The Director has delegated the authority to decide petitions to change the inventorship of patents involved in interferences to the Administrative Patent Judges. Man. Pat. Ex. Proc. § 1002.02(g)5. The Director has also determined that in deciding petitions to change inventorship, consideration shall be limited to determining whether the statements include language required by the statute and rules and no evaluation or comment shall be made as to whether or not it appears that there was deceptive intention. Man. Pat. Ex. Proc. § 1408.

Alcoa has submitted a statement from each of the inventors sought to be added: Mark W. Schaefer, Thomas L. Levendusky, Neville C. Whittle, Robert B. Larsen, and Simon Sheu. Papers 32-36. Each testifies that the error in inventorship occurred through inadvertence without deceptive intent. Alcoa has also submitted the statements of Brian R. Mentz and Timothy F. Dolan, the named inventors of the 657 patent. Papers 37 and 38. Each testifies that they agree with the proposed change in inventorship. Both Alcoa and Applied have filed consents to the change in inventorship through Janet F. Dudestadt, Assistant Secretary, and Mark Turnage, Chief Executive Officer, respectively. Authorization to charge the required fee was included with the petition. Paper 31, p. 3.

Review of the statements indicates that the appropriate language is present and the payment of the required fee has been authorized. Accordingly, the motion and petition to change inventorship are granted.

The filing of settlement agreements is required by 35 U.S.C. § 135(c). Accordingly, the filing of the settlement agreement need not be authorized. The settlement agreement is accepted and, pursuant to Alcoa's request, shall be kept separate from the interference file.

ORDER

It is

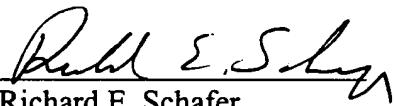
ORDERED that Alcoa's motion and petition to change inventorship be granted;

FURTHER ORDERED that the inventorship of Patent 6,017,657 be changed as reflected on the attached Certificate of Correction;

FURTHER ORDERED that the administrative record of Patent 6,017,657 will be forwarded to the Certificate of Correction branch for entry of the attached Certificate of Correction;

FURTHER ORDERED that the settlement agreement be accepted and be kept separate from the interference file; and

FURTHER ORDERED that a letter acknowledge acceptance of the settlement agreement be issued.



Richard E. Schafer
Administrative Patent Judge

Date: 8/20/04

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